



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/673,798	10/18/2000	Xavier Paliard	PP01521.101	3092

7590

08/13/2003

Anne S Dollard
Chiron Corporation
P O Box 8097
Intellectual Property R338
Emeryville, CA 94662-8097

EXAMINER

LI, QIAN J

ART UNIT	PAPER NUMBER
----------	--------------

1632

14

DATE MAILED: 08/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/673,798

Applicant(s)

PALIARD, XAVIER

Examiner

Q. Janice Li

Art Unit

1632

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 10-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 10-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 May 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

The amendment filed on 5/20/03 has been entered as Paper # 13. Claims 1-3, 5, 7, 11, 13-15, 17, 20, 22, 23,25 have been amended. Claims 1-7 and 10-29 are pending and under current examination.

Unless otherwise indicated, previous rejections that rendered moot in view of the amendment or new grounds of rejections to pending claims will not be reiterated.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 11-13, 16, 17, 21, 25, and 27-29 stand rejected under 35 U.S.C. 102(e) as being anticipated by *Hurwitz et al* (US 5,846,546).

In paper #13, applicants argue that claims have been amended as directed to administering a plasmid containing a sequence encoding the immunogen, Hurwitz discloses only viral vectors, accordingly anticipation cannot be established.

The argument has been fully considered but found not persuasive for reasons of record and following.

Art Unit: 1632

Hurwitz et al clearly teach a plasmid, as well as viral vectors. For example, *Hurwitz et al* teach, "the present invention provides a bi-functional plasmid that can serve as a DNA vaccine and a recombinant virus vector..." (column 4, lines 41-45).

Therefore, the rejection stands.

Claims 11-13, 16, 17, 21, 23-29 stand rejected under 35 U.S.C. 102(e) as being anticipated by *Selby et al* (US 6,355,247).

In paper #13, applicants argue that claims have been amended as directed to administering a plasmid containing a sequence encoding the immunogen, *Selby* discloses only viral vectors, accordingly anticipation cannot be established.

The argument has been fully considered but found not persuasive for reasons of record and following.

Selby et al clearly teach a plasmid, as well as viral vectors. For example, see figure 6, and *Hurwitz et al* teach, "Furthermore, plasmids can be constructed which include a chimeric gene sequence, encoding e.g., a viral or tumor antigen and an immune modulating agent as described above" (column 9, lines 40-44).

Therefore, the rejection stands.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

Art Unit: 1632

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11-21 and 23-29 stand rejected under 35 U.S.C. 103(a) as being unpatentable over *Hurwitz et al* (US 5,846,546) and in view of *DeVico et al* (US 6,214,540).

In paper #14, the applicant indicated that the application and Selby patent were both subject to an obligation of assignment to the same entity at the time the invention was made. Accordingly, the Selby patent has been withdrawn from this rejection.

However, the rejection stands because the combined teachings of *Hurwitz et al* and *DeVico et al* disclose all the elements of the claims stand rejected.

In paper #13, applicants argue that claims have been amended as directed to administering a plasmid containing a sequence encoding the immunogen, and the cited references only teach viral vectors, accordingly the rejection cannot be established

As indicated under section 102, *Hurwitz et al* teach a plasmid vector as vaccine carrier. Therefore, the rejection stands.

Claims 11-13, 16, 17, 21, 27, and 29 stand rejected under 35 U.S.C. 103(a) as being unpatentable over *Chandrashekar et al* (US 6,383,774) in view of *Hurwitz et al* (US 5,846,546).

In paper #13, applicants argue that claims have been amended as directed to administering a plasmid containing a sequence encoding the immunogen, and the cited references only teach viral vectors, accordingly the rejection cannot be established

As indicated under section 102, Hurwitz et al teach a plasmid vector as vaccine carrier. Further, *Chandrashekar et al* also teach using plasmid and recombinant viral vector as the vaccine vector (column 18, lines 22-34).

Therefore, the rejection stands.

Claim Objections

Claim 22 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Claims 1-7 and 10 are allowable.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Q. Janice Li whose telephone number is 703-308-7942. The examiner can normally be reached on 8:30 am - 5 p.m., Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah J. Reynolds can be reached on 703-305-4051. The fax numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9307 for After Final communications.

Any inquiry of formal matters can be directed to the patent analyst, Dianiece Jacobs, whose telephone number is (703) 305-3388.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235. The faxing of such papers must conform to the notice published in the Official Gazette 1096 OG 30 (November 15, 1989).

Q. Janice Li
Examiner
Art Unit 1632

QJL
August 8, 2003

ANNE M. WEHBE, PH.D.
PRIMARY EXAMINER

